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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,816	10/20/2003	Prithipal Singh	11884/408201	4375
26646 7590 08/14/2007 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			EXAMINER MOORTHY, ARAVIND K	
			ART UNIT 2131	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/689,816	Applicant(s) SINGH ET AL.	
	Examiner Aravind K. Moorthy	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is in response to the amendment filed on 21 May 2007.
2. Claims 1-24 are pending in the application.
3. Claims 1-24 have been rejected.

#### ***Response to Amendment***

4. The examiner approves of the amendment made to the abstract. The abstract no longer exceeds the 150-word limit. The examiner withdraws the objection made to the specification.
5. The examiner approves of the amendment made to the claims. No new matter has been added.
6. The examiner approves of the amendment made to claim 18. The amendment to claim 18 overcomes the rejection under 35 U.S.C. 101. The examiner withdraws the rejection.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "on the canvas" in the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**9. Claims 1-4, 6-8, 10-17 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Eskandarian US 2002/0042885 A1.**

As to claim 1, Eskandarian discloses a method for capturing an electronic signature of a user in a java based environment on a personal digital assistant, comprising:

capturing an instance of the electronic signature on the canvas [0051];

encoding by a canvas the instance of the electronic signature in a file

[0051]; and

transferring the file by the canvas to an applet [0051].

As to claims 2 and 14, Eskandarian discloses attaching a pointer to the file by the applet [0067]. Eskandarian discloses the pointer pointing to a business object associated with the electronic signature [0064].

As to claims 3 and 15, Eskandarian discloses communicating by the personal digital assistant the file and the business object to a server [0040].

As to claims 4 and 16, Eskandarian discloses encoding the file and the business object prior to communicating the file and the business object to the server [0061].

As to claims 6 and 17, Eskandarian discloses comparing the file to at least one stored file by the server for consistency [0062].

As to claim 7, Eskandarian discloses producing a rejection message if the server determines that the file and the at least one stored file are not consistent [0064].

As to claim 8, Eskandarian discloses producing an acceptance message if the server determines that the file and the at least one stored file are consistent [0065].

As to claim 10, Eskandarian discloses that the prompting by the applet is in response to a delivery of an item, the electronic signature verifying receipt of the item [0006].

As to claim 11, Eskandarian discloses the method further comprising:

prompting the user by the applet operating on the personal digital assistant [0051]; and

handling the canvas by the applet [0051].

As to claim 12, Eskandarian discloses a personal digital assistant, comprising:

a pressure sensitive screen [0055-0058]; and

a processing system adapted to capture a signature entered via the screen and attach the signature to a business object maintained by the processing system [0055-0058],

wherein the processing system is operated in a java based environment [0051].

As to claim 13, Eskandarian discloses the personal digital assistant, wherein:

the application includes an applet adapted to prompt a user and adapted to handle a canvas [0051]; and

the canvas is adapted to capture an instance of the electronic signature, encode the instance in a file, and transfer the file to the applet [0051].

As to claim 24, Eskandarian discloses a network, comprising:

a mobile device adapted to capture a signature, encode the signature, and attach the encoded signature to a business object [0051]; and

a server adapted to receive the encoded signature attached to the business object from the mobile device [0051];

wherein the server compares the encoded signature to a stored signature file [0051].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandarian US 2002/0042885 A1 as applied to claim 1 above, and further in view of Applied Cryptography (hereinafter Schneier).**

As to claim 5, Eskandarian does not teach that the file and the business object are encoded using an MD5 algorithm.

Schneier teaches the use and benefits of encoding using the MD5 algorithm [page 440].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian so that the file and the business object would have been encoded using an MD5 algorithm.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian by the teaching of Schneier because MD5 has a fourth round added, each step has a unique additive constant and each step now adds in the result of the previous step which promotes faster avalanche effect [page 440].

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**11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandarian US 2002/0042885 A1 as applied to claim 1 above, and further in view of Burger et al U.S. Patent No. 6,938,051 B1.**

As to claim 9, Eskandarian does not teach that the file is a .gif file.

Burger et al teaches the use and benefits of using a .gif file [column 16, lines 7-37].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian so that the signature would have been stored as a .gif file.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian by the teaching of Burger et al because GIF offers clarity and lack of noise on text segments at the expense of increased file size [column 16, lines 7-37].

**12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandarian US 2002/0042885 A1 in view of Burger et al U.S. Patent No. 6,938,051 B1.**

As to claim 18, Eskandarian discloses a computer readable medium embodying computer instructions that, when executed by a computer, perform a method for capturing an electronic signature of a user in a java based environment on a personal digital assistant, the method comprising:

providing a canvas by an applet [0051];

prompting the user by the applet to sign the canvas [0051];

capturing the electronic signature by the canvas [0051];



transferring the formatted electronic signature to the applet from the canvas [0051].

Eskandarian does not teach encoding the electronic signature in the canvas in a .gif format to form a formatted electronic signature.

Burger et al teaches the use and benefits of using a .gif file [column 16, lines 7-37].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian so that the signature would have been stored as a .gif file.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian by the teaching of Burger et al because GIF offers clarity and lack of noise on text segments at the expense of increased file size [column 16, lines 7-37].

As to claim 19, Eskandarian teaches that the method further comprises attaching a pointer to the file by the applet [0064-0067]. Eskandarian teaches the pointer pointing to a business object associated with the electronic signature [0064-0067].

As to claim 20, Eskandarian teaches that the method further comprises communicating by the personal digital assistant the file and the business object to a server [0040].

As to claim 21, Eskandarian teaches that the method further comprises encoding the file and the business object prior to communicating the file and the business object to the server [0040].

As to claim 22, Eskandarian teaches that the method further comprises comparing the file to at least one stored file by the server for consistency [0064].

**13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandarian US 2002/0042885 A1 in view of Applied Cryptography (hereinafter Schneier).**

As to claim 23, Eskandarian discloses a secure signature capturing method for mobile devices, comprising:

pursuant to a first application executing on a mobile device, capturing a signature [0051]; and

pursuant to a second application executing on the mobile device, receiving the signature from the first application and attaching it to a document [0051];

wherein unencrypted data representing the captured signature is inaccessible to any application other than the first application [0051], and

wherein the secure signature capturing method is performed in a java-based environment [0051].

Eskandarian does not teach encrypting the signature.

Schneier teaches the use and benefits of encryption [pages 1-2].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian so that the signature would have been captured and then encrypted. After receiving the encrypted signature it would have been attached to a document.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Eskandarian by the teaching of Schneier because encryption offers authentication, integrity and nonrepudiation [page 2].

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*Conclusion*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy *AM*  
August 8, 2007

*Sma*  
SYED A. ZIA *8/10/07*  
PRIMARY EXAMINER